

REMARKS/ARGUMENTS35 USC § 102

Claims 13-20 were finally rejected under 35 USC § 102 as being inherently anticipated by Miljkovic (U.S. Pat. No. 6,080,425). The applicant respectfully disagrees for various reasons. Nevertheless, and to even more clearly point out that the claimed method is directed to a *new use for a known compound*, the applicant amended claim 13.

The discovery of a *new use for an old structure based on unknown properties* of the structure might be *patentable to the discoverer as a process of using*. *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 163 (CCPA 1957). Without doubt (which is even confirmed by the Office), the presently claimed use is not taught in any prior art document.

With respect to a potential allegation that the presently pending claims would recite using an old composition or structure and that the "use" would be directed to a result or property of that composition or structure, the applicant expressly points out that the claimed use is distinct. More specifically, the *'425 reference is directed to formulations for skin rejuvenation. In contrast, the presently pending claims are directed to compounds that inhibit and enzyme*.

It is appreciated that hindsight may appear tempting in this case (as collagen is found as a skin constituent) to establish inherency of the presently claimed subject matter. However, and as already established in the applicant's previous response, the burden of proof lies with the Office to provide extrinsic evidence that would support the inherency allegation. The applicant's previous arguments are incorporated by reference herein and the applicant further specifically places on record that fact that *the Office failed to address the issue of extrinsic evidence, which is the established criterion for establishing inherency*. With respect to the Examiner's contention that products of identical composition cannot have mutually exclusive properties, the applicant once more points out that it is not the compound that is claimed, but the new use. Thus, the Office's argument fails to logically engage with the claimed subject matter. Consequently, and in view of the above, the rejection should be withdrawn.

In view of the present amendments and arguments, the applicant believes that all claims are now in condition for allowance. Therefore, the applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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